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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oralabs, Inc.

Serial No. 74/546,699

John L. Welsh of Aquilino & Welsh, P.C. for Oralabs, Inc.

Leigh Case, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney)

Before Simms, **Walters** and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

The application filed by Oralabs, Inc. to register the
figure shown below



for "breath freshening drops"¹ was refused registration on the ground that the configuration is de jure functional. The Examining Attorney also indicated that, if the configuration is held to be not de jure functional (and thus could be registered upon a showing of acquired distinctiveness), the evidence submitted by applicant to prove acquired distinctiveness is insufficient for that purpose. Registration was finally refused, and applicant has appealed. Applicant and the Examining Attorney filed briefs, but no oral hearing was requested.

The issues before the Board are whether the applied-for mark is de jure functional, and, if not, whether the container configuration has acquired distinctiveness so that it indicates origin of the goods in applicant.

Preliminarily, we note that applicant's original specimens of record show two types of uses of the applied-for mark: (1) the representation of the design of the bottle on the blue background of the point-of-sale display case for the goods with a "tm" thereon, and (2) the configuration of the container of the goods. Both

¹ Application Serial No. 74/546,699, filed July 7, 1994. Applicant claimed dates of first use and first use in commerce of May 15, 1994. Applicant included a statement that the lining on the drawing is a feature of the mark and is not intended to indicate color.

applicant and the Examining Attorney² have argued only the configuration of the container aspect. Hence, we will consider the appeal on that basis.

The factors involved in determining de jure functionality (i.e., whether or not a particular design is a superior one) are: (i) the existence of a utility patent showing the functional advantage of the design; (ii) advertising materials showing that the utilitarian advantages have been touted by applicant; (iii) facts tending to show an absence of alternative designs; and (iv) facts from which it could be determined that the design is the result of a comparatively simple or inexpensive method of manufacture. See *In re Morton-Norwich Products Inc.*, 671 F.2d 1332, 213 USPQ 9 (CCPA 1982).

The Examining Attorney argues that applicant touts the utilitarian aspects of its mark in that the specimens (point-of-sale display cases) show that applicant's small bottle holds "over 150 drops" and applicant has argued that the bottle was designed to fit into a pocket. Thus, the Examining Attorney asserts that the configuration allows the product to be small in size but with substantial

² In the first Office action (page 2) the Examining Attorney stated that "while use of the proposed mark in (sic-on) the packaging is 'trademark use', as evidenced by the specimens, such use is not enough to overcome the apparent functionality and nondistinctiveness of the proposed mark".

capacity. Further, the Examining Attorney asserts that use of the same or highly similar designs by competitors indicates the lack of competitive designs; and that applicant's cylindrical bottle shape appears inexpensive to manufacture, and thus constitutes a comparative advantage necessary to competitors. Finally, the Examining Attorney also points out that the absence of a patent or patent application by applicant does not show applicant's applied-for mark is registrable.

In support of her position that the applied-for mark is de jure functional, the Examining Attorney submitted photographs of three breath freshener bottles "identical to applicant's bottle" owned by three separate entities (final Office action, page 2).

Applicant's position is that the applied-for mark is not de jure functional. Applicant specifically argues the Morton-Norwich factors, supra, that there is no patent or patent application for this matter; that the fact that the bottle holds 150 drops of breath freshener relates to the size of the opening of the bottle dropper, not to the size and/or shape of the bottle itself, and there is a lack of evidence that applicant touts the shape of the bottle in its advertisements; that there are numerous alternative shapes and designs of bottles for breath fresheners

available to competitors (including one sold under the mark "sweet breath" submitted with applicant's brief)³; and that the Examining Attorney's statement that the bottle appears to be inexpensive to manufacture is unsupported by evidence, and "the manufacture of bottles has reached a point where almost any bottle design may be easily and inexpensively manufactured." (Applicant's brief, page 8.)

We should point out that the mere existence of a function does not render a configuration unregistrable (i.e., many containers are capable of holding liquid, a function; but the ability to hold liquid does not render every liquid container configuration unregistrable.) To be considered de jure functional, it must be shown that not only does the container have a function, but performance of that function is enhanced by the particular configuration that it takes. See *In re Virshup*, 42 USPQ2d 1403 (TTAB 1997).

³ Along with its appeal brief, applicant submitted a product sample and the display backing of a competitor's product, "sweet breath" breath freshening drops. The Examining Attorney did not object to the evidence, and in fact, treated it as being of record. Accordingly, the Board has considered that material. However, the Board notes that in applicant's June 5, 1995 response to the first Office action, applicant referred to several other such competitors' product samples made of record in a co-pending application. The other product samples are not of record herein and cannot be considered. Each file must be complete and each case must be decided on its own separate record.

The Examining Attorney bears the burden of making a prima facie showing of de jure functionality of the applied-for mark. After considering the Examining Attorney's evidence and arguments regarding the Morton-Norwich factors, supra, we find the Office has not met this burden. The only evidence submitted by the Examining Attorney is three photographs of similar bottles used by three separate entities for similar goods. Apparently the Examining Attorney presumes that this showing of competitors' use of similar designs alone establishes the design confers a competitive advantage. However, this evidence is insufficient to establish that the involved container configuration is de jure functional, especially in light of the following facts: (i) applicant stated it does not own a patent or a patent application; (ii) there is no evidence of any patents owned by third parties; (iii) applicant's specimens (point-of-sale display cases) do not include "touting" of the configuration by applicant; (iv) there is no evidence of applicant's "touting" the configuration in its advertisements; and (v) there is no evidence as to the relative price of producing containers in various shapes for these goods.

In the case of *In re R. M. Smith, Inc.*, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984), the Court recognized that the

initial analysis may be of the separate features of the involved configuration, followed by consideration of the entire design. That is, while we must consider the applied-for mark as a whole, it is appropriate to look at the components of the configuration. In this case, in the absence of any evidence to the contrary, the Board assumes that the simple cylindrical shape of the lower portion of applicant's bottle is one of the best and most inexpensive shapes for a small bottle, i.e., the cylindrical bottom portion of the bottle is de jure functional; and that the ribbed portion of the cap is for gripping and twisting the cap in order to easily open same, and is likewise de jure functional. Nonetheless, the Examining Attorney has not provided evidence as to why the cap covering the tapered portion of the bottle needs to be either tapered or flat topped. That is, the Examining Attorney submitted no evidence why the applied-for mark is a superior design of a cap for a bottle to hold breath freshening drops. The cap portion of the bottle is a significant aspect of the overall configuration. Thus, considering the overall configuration, there is nothing to indicate or prove that the applied-for container configuration has such superiority over other possible designs that competitors need the freedom to copy this design in order to

effectively compete with applicant. The fact that a few other entities utilize a similar shape does not establish that the container configuration as applied for by applicant is de jure functional.

Based on the record before us, we find that the Examining Attorney has not made a prima facie showing of de jure functionality of the configuration as a whole.

Turning now to the issue of acquired distinctiveness⁴, we find applicant's evidence to be inadequate to prove that the applied-for configuration is recognized as applicant's trademark. In support of the claim of acquired distinctiveness, applicant submitted the declaration of Gary Schlatter, president of applicant, and the affidavit of Brian Crozier, "an authorized signing officer of Cool Drops (Canada) Inc. ("Cool Drops"), a direct competitor" of applicant. Mr. Crozier states in his affidavit that applicant's bottle design is proprietary to applicant, and that the design is distinctive. The affidavit indicates that Mr. Crozier is located in Toronto, Canada, and is an

⁴ In applicant's response to the first Office action applicant argued that its mark is inherently distinctive. However, in applicant's request for reconsideration after the final Office action, applicant asserted that its "bottle design has acquired distinctiveness" under Section 2(f). Thus, we consider applicant to have conceded that its applied-for mark is not inherently distinctive and, in any event, we find that it is not inherently distinctive.

employee of a competitor of applicant, which is also located in Canada. Any use of the mark by applicant in Canada, and acknowledgment from a competitor in Canada, is irrelevant to the question of whether the configuration has acquired distinctiveness in the United States. The declaration of applicant's president, Gary Schlatter, includes no evidence of public recognition of the involved bottle design. Mr. Schlatter's statements as to the amount of advertising dollars (\$670,000 for 1993 - 1996), the units of sales (over 42 million bottles to date), and the dollar amount of sales (over \$10 million for 1993 - 1996) are significant numbers. However, there is no clear indication what portion, if any, of these numbers relate solely to the bottle design, rather than applicant's trademark, ICE DROPS. That is, there is no information in the declaration specifically relating to the bottle design as opposed to applicant's trademark ICE DROPS, under which applicant's goods are sold. Moreover, this evidence does not demonstrate that the container configuration is recognized as a source indicator. Rather, it shows only that applicant has, in fact, advertised, promoted and sold its goods. See *In re American National Can Co.*, 41 USPQ2d 1841 (TTAB 1997); and *In re Semel*, 189 USPQ 285 (TTAB 1975).

Accordingly, we find that applicant has not established that the container configuration has acquired distinctiveness. Moreover, the photographs of similar bottle designs used by three competitors indicate that applicant's bottle design differs only slightly from some others, thus rendering applicant's claim of acquired distinctiveness less convincing.⁵

Decision: The refusal to register the applied-for mark as de jure functional is reversed, and the applicant's evidence of acquired distinctiveness is insufficient to establish that the container configuration has become distinctive through use in commerce.

R. L. Simms

C. E. Walters

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

⁵ Applicant's request in its brief that, if the Board determines the applied-for mark is not de jure functional, then we should remand the application to the Examining Attorney for further evidence on the question of acquired distinctiveness is denied. The record must be complete prior to filing an appeal. Trademark Rule 2.142(d). An application considered and decided on appeal will not be reopened, except for entry of a disclaimer or upon order of the Commissioner. Trademark Rule 2.142(g). Applicant had ample opportunity to present its evidence of distinctiveness before the Examining Attorney, and either had no further evidence, or chose not to submit such evidence.